



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,209	10/02/2003	Robert Francis Squibbs	B-5250 621318-0	2114
7590 03/07/2008 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER GEBRIEL, SELAM T	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 03/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/678,209

Applicant(s)

SQUIBBS, ROBERT FRANCIS

Examiner

SELAM T. GEBRIEL

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/02/2003, 04/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 5, 6, 8, 9, 10, 12, 14, 17, 20, 23, 24 and 25 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 4, 5, and 9 of copending Application No.10/678210. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Although the conflicting claims are not identical they are not patentable distinct from each other because the instant application on claims 1, 5, 6, 10, 12, 14, 17, 20 and 25 are generic to all that is recited in claims 1 and 9 of the application 10/678,210.

This application claim 8 and 23 are identical to claim 4 of the copending application 10/678,210.

This application claim 9 and 24 are identical to claim 5 of the copending application 10/678,210.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Specification

1. The disclosure is objected to because of the following informalities: Page 2, line 2 Page 3, Line 30, and Page 7, Line 8, the word **whilst** should be changed to **while**.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 31 are rejected under 35 U.S.C. 102 (b) as being anticipated by Sato ET al. (US 2001/0024236 A1).

4. **Regarding claim 1**, Sato discloses a method of providing for the taking of a combined picture, the method comprising:

(a) at a site of interest, using a data-storage (Figure 2, Element 45) element to store data comprising an historical image or a reference to it (Page 3, Paragraph 0038);

(b) using a camera both (I) to read the stored data at the site whereby to directly, or by following a said reference, download said historical image as first image digital data and (II) to optically capture a current image at the site to form second image data (Page 3, Paragraph 0037 and Page 6, Paragraph 0085, 0086 and 0087);

(c) in the camera, combining said first and second image data to form a combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034); and

(d) storing the picture in a picture memory of the camera (Figure 9, S228, Page 5, Paragraph 0078).

5. **Regarding claim 2**, Sato further discloses a method according to claim 1, wherein in step (b) said stored data is read using a data interface of the camera that requires to be positioned at or juxtaposed the data-storage element (Page 3, Paragraph 0037 and Page 6, Paragraph 0085 and 0086).

6. **Regarding claim 3**, Sato further discloses a method according to claim 1, wherein step (c) is carried out by an image-combining arrangement of the camera, the

Art Unit: 2622

historical image downloaded in step (b) being automatically provided to the image-storage arrangement at the time the image is downloaded (Page 3, Paragraph 0043 and 0044, The received image can also be recorded in RAM provided in the information processing device 26).

7. **Regarding claim 4**, Sato further discloses a method according to claim 1, wherein in step (b) the second image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), step (c) using the current second image data in forming said combined picture.

Regarding claim 5, Sato further discloses a method according to claim 1, wherein in step (c) the positioning and/or size of the first image in the combined picture is electronically controlled (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

8. **Regarding claim 6**, Sato further discloses a method according to claim 1, in step (b) the second image data changes as the scene pointed to by the camera changes, step (c) using the current second image data in forming said combined picture and step (c) involving electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

9. **Regarding claim 7**, Sato further discloses a method according to claim 6, wherein the positioning of the first image in the combined picture is incrementally controlled (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is one that set the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

10. **Regarding claim 8**, Sato further discloses a method according to claim 1, wherein in step (c) the first image is placed in foreground relation with the second image (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is one that set the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

11. **Regarding claim 9**, Sato further discloses a method according to claim 1, wherein in step (c) the first image is placed in background relation with the second image (Figure 9, S224, Page 4, Paragraph 0060), The user of the camera is one that set the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

12. **Regarding claim 10**, Sato discloses a system (Figure 2) that provides for the taking of a combined picture, the system comprising:

- a data-storage element (Figure 2, Element 45) provided at a site of interest for storing data comprising historical image or a reference to it (Page 3, Paragraph 0038) ; and
- a camera (Figure 1, Element 10) comprising:

- a first subsystem (Figure 1, Element 32) arranged to read the data stored in said data-storage element whereby to directly, or by following a said reference, download to the camera said historical image as first image data;

- a second subsystem (Figure 1, Element 12) for converting an optically-input second image into second digital image data;

- an image-combining arrangement (Figure 1, Element 20, 21, 22,24,26 and 28), including a display (Figure 1, Element 28), for combining the images represented by the first and second image data to form a combined picture; and

- a picture storage arrangement responsive to user input to store said combined picture (Figure 9, S228, Page 5, Paragraph 0078).

13. **Regarding claim 11**, Sato further discloses a system (Figure 2) according to claim 10, wherein the first subsystem of the camera is arranged to automatically pass the first image data to the image-combining arrangement at the time that the first image data is downloaded (Page 3, Paragraph 0044, The received image can also be recorded in RAM provided in the information processing device 26).

14. **Regarding claim 12**, Sato further discloses a system (Figure 2) according to claim 10, wherein the first subsystem (Figure 1, Element 32) of the camera comprises a data interface that requires positioning at, or in juxtaposition to, said data-storage element in order to read therefrom said first image data or a reference to it, whereby selection of a desired said first image is effected by appropriately physical positioning the camera to enable the data interface to read the data storage element corresponding to the desired first image (Page 3, Paragraph 0037 and Page 6, Paragraph 0085 and 0086).

15. **Regarding claim 13**, Sato further discloses a system (Figure 2) according to claim 10, wherein the second subsystem (Figure 1, Element 12) of the camera is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement being arranged to form said combined picture using the current second image data (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

16. **Regarding claim 14**, Sato further discloses a system (Figure 2) according to claim 10, wherein the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) further includes user-operable first-image control means for (Figure 1, Element 20, 21, 22, 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

17. **Regarding claim 15**, Sato further discloses a system (Figure 2) according to claim 10, wherein the second subsystem (Figure 1, Element 12) is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement being arranged to form said combined picture using the current second image data, and the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) further including user-operable first-image control means for (Figure 1, Element 20, 21, 22, 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

18. **Regarding claim 16**, Sato further discloses a system (Figure 2) according to claim 15, wherein the first-image control means is arranged to incrementally control the positioning of the first image in the combined picture (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

19. **Regarding claim 17**, Sato discloses a camera (Figure 1, Element 10) comprising:

- a first subsystem (Figure 1, Element 32) for electronically downloading, from externally of the camera, first digital image data representing a first image, the first subsystem comprising a data interface that requires positioning at, or in juxtaposition to, an external data-storage element in order to read therefrom said first image data or a reference to it, whereby selection of a desired said first image is effected by appropriately physical positioning the camera to enable the data interface to read the data-storage element corresponding to the desired first image (Page 3, Paragraph 0037 and Page 6, Paragraph 0085 and 0086);

- a second subsystem (Figure 1, Element 12) for converting an optically-input image into second digital image data (Page 2 and 3, Paragraph 0034);

- an image-combining arrangement (Figure 1, Element 20, 21, 22,24,26 and 28), including a display (Figure 1, Element 28), for combining the images represented by the first and second image data to form a combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034); and

- a picture storage arrangement responsive to user input to store said combined picture (Figure 9, S228, Page 5, Paragraph 0078).

20. **Regarding claim 18**, Sato further discloses a camera according to claim 17, wherein the first subsystem is arranged to automatically pass the first image data to the image-combining arrangement at the time that the first image data is downloaded (Page 3, Paragraph 0044, The received image can also be recorded in RAM provided in the information processing device 26).

21. **Regarding claim 19**, Sato further discloses a camera according to claim 17, wherein the second subsystem (Figure 1, Element 12) is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) being arranged to form said combined picture using the current second image data (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

22. **Regarding claim 20**, Sato further discloses a camera according to claim 17, wherein the image-combining arrangement further includes user-operable first-image control means for (Figure 1, Element 20, 21, 22 and 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

23. **Regarding claim 21**, Sato further discloses a camera according to claim 17, wherein the second subsystem (Figure 1, Element 12) is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) being arranged to form said combined picture using the current second image data, and the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) further including user-operable first-image control means for (Figure 1,

Element 20, 21, 22 and 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

24. **Regarding claim 22**, Sato further discloses a camera according to claim 21, wherein the first-image control means is arranged to incrementally control the positioning of the first image in the combined picture (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

25. **Regarding claim 23**, Sato further discloses a camera according to claim 17, wherein the image-combining arrangement is arranged to place the first image in foreground relation with the second image (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

26. **Regarding claim 24**, Sato further discloses a camera according to claim 17, wherein the image-combining arrangement is arranged to place the first image in

Art Unit: 2622

background relation with the second image (Figure 9, S224, Page 4, Paragraph 0060,

The user of the camera is the one that sets the combined position of the optically-

captured image therefore the user has the option to position the optically-captured

image in foreground relation with the received image or in background with the received

images).

27. **Regarding claim 25**, Sato discloses a camera (Figure 1, Element 10)

comprising:

- a first subsystem (Figure 1, Element 32) for electronically downloading, from externally of the camera, first digital image data representing a first image; the first subsystem being arranged to read said first image data or a reference to it from a data-storage element installed in the local environment (Page 3, Paragraph 0037 and Page 6, Paragraph 0085 and 0086);

- a second subsystem (Figure 1, Element 12) for converting an optically-input second image into second digital image data (Page 2 and 3, Paragraph 0034);

- an image-combining arrangement (Figure 1, Element 20, 21, 22,24,26 and 28), including a display (Figure 1, Element 28), for combining the images represented by the first and second image data to form a combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034); and

- a picture storage arrangement responsive to user input to store said combined picture (Figure 9, S228, Page 5, Paragraph 0078);

the first subsystem being arranged to automatically pass the first image data to

the image-combining arrangement at the time that data is downloaded (Page 3, Paragraph 0044, The received image can also be recorded in RAM provided in the information processing device 26).

28. **Regarding claim 26**, Sato further discloses a camera according to claim 25, wherein the second subsystem is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement being arranged to form said combined picture using the current second image data (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

29. **Regarding claim 27**, Sato further discloses a camera according to claim 25, wherein the image-combining arrangement further includes user-operable first-image control means for (Figure 1, Element 20, 21, 22 and 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 9, Page 5, Paragraph 0078).

30. **Regarding claim 28**, Sato further discloses a camera according to claim 25, wherein the second subsystem (Figure 1, Element 12) is so arranged that said second digital image data changes as the scene pointed to by the camera changes (Page 2 and 3, Paragraph 0034), the image-combining arrangement (Figure 1, Element 20, 21, 22, 24, 26 and 28) being arranged to form said combined picture using the current

Art Unit: 2622

second image data, and the image-combining arrangement further including user-operable first-image control means for (Figure 1, Element 20, 21, 22 and 24) electronically controlling the positioning and/or size of the first image in the combined picture (Figure 4, Figure 9, Page 5, Paragraph 0078 and Page 2 and 3, Paragraph 0034).

31. **Regarding claim 29**, Sato further discloses a camera according to claim 28, wherein the first-image control means is arranged to incrementally control the positioning of the first image in the combined picture (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

32. **Regarding claim 30**, Sato further discloses a camera according to claim 25, wherein the image-combining arrangement is arranged to place the first image in foreground relation with the second image (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

33. **Regarding claim 31**, Sato further discloses a camera according to claim 25, wherein the image-combining arrangement is arranged to place the first image in background relation with the second image (Figure 9, S224, Page 4, Paragraph 0060, The user of the camera is the one that sets the combined position of the optically-captured image therefore the user has the option to position the optically-captured image in foreground relation with the received image or in background with the received images).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SELAM T. GEBRIEL whose telephone number is (571)270-1652. The examiner can normally be reached on Monday-Thursday 7.30am-5.00pm.

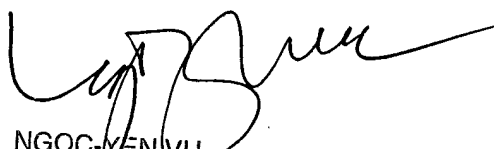
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu NgocYen can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.G.

Monday, February 11, 2008



NGOC-YEN VU
SUPERVISORY PATENT EXAMINER